



#16 DAC

PATENT
Attorney Docket No.: A-68104/RMS/JJD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<u>In re</u> application of:)	Examiner:	T. WESSENDORF
)		
Joseph FISHER, et al.)	Group Art Unit:	1618
)		
Serial No.: 09/293,670)		
)		
Filing Date: April 16, 1999)		
)		
For: MULTIPARAMETER FACS)		
ASSAYS TO DETECT)		
ALTERATIONS IN CELLULAR)		
PARAMETERS AND TO SCREEN)		
SMALL MOLECULE LIBRARIES)		
)		

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on 5 March 2001.

Signed: _____

Todd V. Leone

PETITION UNDER 37 C.F.R. § 1.181

Office of Petitions
Assistant Commissioner
Washington, DC 20231

Sir:

This is a petition under 37 C.F.R. § 1.181 to review the Examiner's decision to make final. While Applicants believe that no fees are due at this time, the Commissioner

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is authorized to charge any, fees including extension fees or other relief, which may be required or credit any overpayment to Deposit Account No. 06-1300 (Our Order No. A-68104/RMS/JJD).

Statement of Facts

The application in question was filed April 16, 1999, comprising Claims 1-10. Examination on the merits commenced with the issuance of a first Office Action, mailed October 6, 1999. In this Office Action, Claims 1-7 were rejected; Claims 8-10 were objected to for improper form. Specifically, Claims 1-7 were rejected under 35 U.S.C. § 102(a) over Nolan, WO 97/27212 (Nolan), Claim 3 was rejected under 35 U.S.C. § 102(e) over Kamb, USPN 5,955,275 (Kamb), and Claims 5-6 were rejected under 35 U.S.C. § 103(a) over Nolan or Kamb in view of Hide et al., *J. Cell Biol.* 123(30:585-593 (1993) (Hide). Claims 1-7 were also provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Claims 8-10 were objected to for constituting a multiple dependent claim depending from a multiple dependent claim. This was the only adverse statement regarding these claims.

Applicants replied to the first Office Action on March 6, 2000, in which response amendments to the claims were entered and full response to the rejections made. Of particular relevance, Claims 8 was amended only so far as to include dependence from added claims. Claim 9 was amended only so far as to limit the claims from which it depended. Claims 5 and 7 were amended so that Claims 8-10 no longer depended from multiple dependent claims. Among the claims added by amendment in this response, Claim 14 was added depending only from Claim 8.

Responsive to Applicants submission of March 6, 2000, a Final Office Action was mailed July 5, 2000. In this Office Action, Claim 1-4, 7-10 and 13-14 were rejected under 35 U.S.C. § 102(a) over Nolan, where previously only Claims 1-7 had been rejected. Claims 3, 8, 10 and 14 were rejected under 35 U.S.C. § 102(e) over Kamb,

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where previously only Claim 3 had been rejected. And, Claims 5-6 and 11-12 were rejected under 35 U.S.C. § 103(a) over Nolan or Kamb in view of Hide, when previously only Claims 5-6 had been rejected. Claims 11 and 12, added in the response of March 6, 2000, depend (directly or indirectly) from Claim 4, not Claim 5 or Claim 6.

Applicants timely filed a response to the July 5, 2000 Office Action on January 5, 2001. In this response, amendments were submitted and, in addition to responding to the substantive examination, arguments were posed objecting to the making final of the Office Action in light of the new rejections. A request for reconsideration was formally submitted.

An Advisory Action responsive to Applicants January 5, 2001 response was mailed January 30, 2001. The Advisory Action indicated that the amendments from Applicants' previous response would not be entered because they raised new issues. The Advisory Action stated that "the finality of the Office Action is proper since the rejections of the claims made in the previous Office Action were simply reiterated and maintained."

Points to be Reviewed and Action Requested

Applicants hereby request review of the making final of the Office Action mailed July 5, 2000 in the present application. Applicants submit that the making final of this Office Action was premature, because the rejections constituted new grounds of rejection, at least as to Claims 8-10 and 12-14. Applicants respectfully request that the Examiner be directed to withdraw the finding of finality, enter the amendments submitted January 5, 2001, and proceed with further examination on the merits of the application. In addition, Applicants request a refund of the fee for the Notice of Appeal which should not have been necessitated by the Office Action in question.

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If the Commissioner believes there is anything presented in this petition requiring clarification or any other issue raised which may be resolved by telephone, Applicants request that the undersigned attorney be contacted at (415) 781-1989.

Respectfully submitted,

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP

Dated: 5 March 2001

By James J. Diehl
James J. Diehl
Reg. P-47,527

Four Embarcadero Center - Suite 3400
San Francisco, California 94111-4187
Tel.: (415) 781-1989
Fax: (415) 398-3249

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